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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/209,454

12/11/1998

HIDENARI TANAKA

88125/ASAHIN

6958

23548 7590 06/02/2008

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EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

06/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/209,454	TANAKA ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17, 18 and 20-22 have been examined. Application 09/209,454 (**METHOD OF SELLING CONTACT LENS**) has a filing date 12/11/1998 and foreign priority date 12/12/1997.

Response to Amendment

2. In response to BPAI Decision filed 01/18/2008, the Applicant filed an RCE on 02/21/2008, which amended claims 17, 21 and cancel claim 19.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741).

As per claim 17, Pauly et al teach:

A method of selling prescription contact lenses said method comprise:

transferring contact lens customer identification, address, and diagnostic data pertaining to a respective contact lens customer from a plurality of second group information processing apparatus located at respective facilities of contact lens

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prescribers, the plurality of second group information processing apparatus being connected through a communication network to a first group information processing apparatus located at a facility of a contact lens seller, to the first group information processing apparatus through the communication network (see Pauly column 2, line 35 – column 3, line 5; column 3, line 36 – column 4, line 38; column 5, lines 4-18; column 6, lines 11-33);

assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the contact lens seller (see Pauly column 6, lines 39-45);

paying a monthly fee by the contact lens customer to the contact lens seller (see Pauly col 3, lines 20-25; col 8, lines 35-65; “effective billings on desired periodic basis, either directly to the patient, to or through the eye care professional or through automatic credit procedures such as credit card charges”)

Fay teaches:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network (see Fay column 5, line 55 – column 6, line 54);

delivering a contact lens from the selling agent to the customer (see Fay column 6, lines 35-54);

transferring delivery data from the selling agent to the contact lens provider through the communication network (see Fay column 6, lines 48-54).

Although the Fay system relates to the selection of eyeglass frames and not to contact lenses, it can be used to view, select, and purchase other related products (see Fay column 9, lines 4-8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly system would deliver the purchase product, in this case contact lenses, to a selling agent that would take care of delivering the product to the customer, as taught by Fay. Therefore, if the selling agent is an optical retail store (see Fay column 6, lines 35-40), the customer would go to that store to pick up the product and this way he/she would save the shipping and handling charges.

Pauly fails to teach:

writing, through both the first group information processing apparatus and the plurality of second group information processing apparatus, on respective portable recording media for each contact lens customer, data, including the corresponding registration number, and issuing the corresponding portable recording medium to the respective customer, so the contact lens customer can select any contact lens prescriber, and change between any contact lens prescriber, having access to one of the second group information processing apparatus and the communication network without changing the contact lens seller; determining an exchange time for exchanging the contact lens, based upon date of issuance of the contact lens and characteristics of the contact lens, by the first group information processing apparatus of the contact lens seller, using data recorded on the portable recoding medium of the corresponding contact lens customer to whom a contact lens has been issued by the contact lens

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seller through the selling agent; and notifying a contact lens customer to whom a contact lens was issued of the exchange time. However, Eberhardt teaches a portable recording media that stores patient's medical data, such as prescription information, expiration date, date of purchase, refills and prescription's date of completion (see Eberhardt column 3, lines 39-67; column 4, lines 50-53; column 14, lines 13-36). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would use a portable recording media, as taught by Eberhardt, to store contact lenses' prescription data. A contact lens customer would present the portable recording media to any contact lens prescriber, that would read the portable recording media and obtain an accurate information about the customer history of lens usage, even when the customer is very ill, unconscious, unable to speak or ignorant about his or her medical history.

Pauly does not expressly teach supplying by the selling agent of new contact lenses to the contact lens customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses in exchange for the monthly payment by the contact lens customer to the contact lens seller. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that even though a patient would have a set up wear schedule where it would receive new contact lenses according to a set up time, as taught by Pauly (see column 7, lines 10-21), if for whatever reason the patient breaks a contact lens or scratches it, even though he/she is not scheduled to receive new contact lenses, he/she

may choose to get them out of schedule because out of convenience, his or her preference and/or the better quality of vision provided by the contacts.

As per claim 21, Pauly teaches:

including contracting for a one year term with the respective contact lens customer for supplying long-term-use contact lenses in exchange for the old contact lenses and the monthly payment (see column 7, lines 9-48) *by the contact lens customer to the contact lens seller* (see Pauly col 3, lines 20-25; col 8, lines 35-65; "effective billings on desired periodic basis, either directly to the patient, to or through the eye care professional or through automatic credit procedures such as credit card charges")

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741) and Dawson, Jr. et al (U.S. 5,623,242).

As per claim 18, Pauly but does not expressly teach including delivering notification of an approaching deadline to replace the contact lens from the contact lens seller to the contact lens customer through the communication network. However, Dawson teaches a system where patient prescription information is entered and stored in a database and a remainder signal is generated and transmitted to a patient in response to the stored information (see Dawson column 2, lines 10-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would store a patient's prescription wear

schedule in a database and would send a remainder message to the patient that would indicate that the time to replace the contact lenses is due. This feature would help patients have a new supply of contact lenses on hand.

5. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of the article Cashing in on quicker delivery times and Eberhardt (U.S. 5,659,741).

As per claim 20, Pauly fails to teach including periodically offering for sale contact lens care articles by the contact lens seller to the customer through the communication network. However, the article Cashing in on quicker delivery times teaches about a system where the contact lens provider offers to its customers 99.99 percent on-time delivery of its product when using the contact lens provider ordering network and offers customers the option of ordering product direct from local distributors (see paragraphs 3-7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would receive products updates periodically, as taught by the article. This feature would give customers a reliable venue to obtain the products related to their contact lens care.

As per claim 22, Pauly fails to teach including periodically offering for sale the contact lens care articles based upon a consumption period of the contact lens care articles and date of most recent sale of the contact lens care articles to the respective contact lens customer transmitted from the first group information processing apparatus. Pauly teaches a system that changes the wear schedule and shipment of the contact

lenses deliver to customers (see column 7, lines 9-11). And as explained in claim 20, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would be able to change the wear schedule and shipment schedule, as taught by Pauly. This feature would give customers a reliable venue to obtain the products related to their contact lens care.

Response to Arguments

6. Applicant's arguments filed 02/21/2008 have been fully considered but they are not persuasive. The Applicant argues that Pauly does not teach the limitation of "monthly payment from the contact lens customer to the contact lens seller" and that the payment for replacing contact lenses is made to the contact lens seller. The Examiner answers that Pauly teaches paying a monthly fee by the contact lens customer to the contact lens seller (see Pauly col 3, lines 20-25; col 8, lines 35-65; "effective billings on desired periodic basis, either directly to the patient, to or through the eye care professional or through automatic credit procedures such as credit card charges"). Therefore, contrary to Applicant's argument, Pauly teaches Applicant's claimed limitation.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
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May 24, 2008